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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/973,261	11/09/92	CANICH	J P-1817-D2

EXAMINER

WU, D

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ART UNIT	PAPER NUMBER
1505	4

DATE MAILED: 04/13/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 14-26 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-13 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 14-26 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

15.

Claims 14-26 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-13 of copending application Serial No. 07/973,107. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

16.

The claimed invention is identical to the application Serial No. 07/973,107.

17.

Claims 14-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,026,798. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping.

18.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

19.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

20.

> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

21.

Claims 14-26 are provisionally rejected under 35 U.S.C. 102(g)/103 as being obvious over count 1 of Interference No. 102,954.

22.

In view of Canich's teaching at column 8, lines 46-54 and column 10, lines 49-51, it would have been obvious to one having ordinary skill in the art to exclude Q as a substituted or unsubstituted cyclopentadienyl ring in the broadest claim of count 1 of Interference No. 102,954.

23.

The rejection of claims 14-26 above based upon count 1 of Interference No. 102,954, to which applicant is a party, is a provisional rejection for the purpose of resolving all remaining

issues in this application. The provisional assumption that the count is prior art under 35 U.S.C. § 102(g) against this application may or may not be true, and prosecution in this case will be suspended pending final determination of priority in the interference if and when no other issues remain.

Joseph L. Schofer

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SUPERVISORY PATENT EXAMINER
ART UNIT 155

DW

Wu/slh
April 09, 1993